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REMARKS

Claims 7, 10, 12, and 14-23 were previously presented for examination in the present application. This Amendment cancels claims 7, 10, 12, 15, and 16 without prejudice. Thus, claims 14, and 17-23 are presented for consideration upon entry of this Amendment, which is respectfully requested.

Claim 14 has been amended to correct a grammatical error, namely to change the verb tense from "disposed" to "being disposed". It is respectfully submitted that this amendment to claim 14 merely makes explicit what had been implicit in the claim.

The outstanding Office Action objected to the drawings under 37 C.F.R. 1.83(a). However, the present application has no drawings. In light of the above, reconsideration and withdrawal of this objection is respectfully requested.

Claims 15 and 16 have been cancelled for purposes of advancing prosecution. The cancellation of claims 15 and 16 obviates the rejection under 35 U.S.C §112. Thus, reconsideration and withdrawal of this rejection are therefore respectfully requested.

Claims 7, 10, 12, 14, and 19-23 were rejected under 35 U.S.C. §102(b) over U.S. Patent Nos. 4,837,668 to Koehler (Koehler) and 5,641,219 to Mizobe (Mizobe).

Claims 7, 10, and 12 have been cancelled for purposes of advancing prosecution. Reconsideration and withdrawal of the rejection of claims 7, 10, and 12 are therefore respectfully

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requested.

Claim 14 requires, in part, a substrate and a protective plastic coating being disposed on the substrate. The protective plastic coating has a first thickness that is sufficient to retain particles of the substrate upon explosion of the high-pressure gas discharge lamp.

The Office Action asserts that a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish over the prior art. As support for this assertion, the Office Action cites the holdings of *In re Casey* and *In re Otto*.

It is respectfully submitted that the Office Action applied the incorrect law to the claims at issue.

*In Re Otto* provides "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

*In re Casey* provides, in pertinent part, that "the perforating device had the structure of the taping device as claimed, the difference was in the use of the device", and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself." *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967).

*The Manual of Patent Examining Practice* specifically

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cautions that, "Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use" (emphasis added). See Manual of Patent Examining Practice, Section 2115.

In the present application, Applicants are not asserting that the use of the reflector with the data projector imparts patentability. Further, Applicants are not asserting that manner or method in which the claimed reflector is utilized is germane to the issue of patentability of the machine itself. Rather, Applicants submit that claim 14 defines the structural features of an explosion resistant reflector.

Claim 14 defines the structure of the protective plastic coating's thickness as being sufficient to retain particles of the substrate upon explosion of the high-pressure gas discharge lamp.

Koehler provides a glass substrate 50 having a coating 64 and a suitable conventional PTFE (Teflon) paint layered atop the dichroic coating. See Col. 4, lines 36-43. The PTFE (Teflon) paint is layered over the dichroic coating to aid in preventing damage to the dichroic coating from peeling and from cleaning or handling. See Col. 1, lines 32-50.

Mizobe provides a thin transparent sheet or plate 2 or a coating layer 2 disposed on the emitting surface of the substrate 1 for keeping light in the substrate 1. See Col. 3, lines 43-45.

Accordingly, it is respectfully submitted that neither Koehler nor Mizobe disclose or suggest the structure required by

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claim 14. Koehler and Mizobe simply do not disclose or suggest a protective plastic coating having a thickness sufficient to retain particles of the substrate upon explosion of the high-pressure gas discharge lamp.

Claim 14 is therefore in condition for allowance. Since claims 19-23 depend from claim 14, these claims are also in condition for allowance. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 17 and 18 were rejected under 35 U.S.C. §103(a) in view of Koehler or Mizobe. The Office Action admits that Koehler and Mizobe fail to disclose or suggest the thicknesses claimed in either claim 17 or claim 18. However, the Office Action asserts that discovering the optimal or workable ranges involves only routine skill in the art. Applicants respectfully traverse this rejection.

For purposes of advancing prosecution of the present application, claims 17 and 18 have been amended into independent form. Thus, claims 17 and 18 have each been amended to incorporate the elements of claim 14.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01.

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There is no teaching, suggestion, or motivation in Koehler, Mizobe, or any combination thereof, to modify their respective coatings in an attempt to produce the specific coating thicknesses claimed in claims 17 and 18.

Again, Koehler provides PTFE (Teflon) paint layered over the dichroic coating to aid in preventing damage to the dichroic coating from peeling and from cleaning or handling. See Col. 1, lines 32-50. Further, Mizobe provides a thin transparent sheet or plate 2 or a coating layer 2 disposed on the emitting surface of the substrate 1 for keeping light in the substrate 1. See Col. 3, lines 43-45.

Since Koehler does recognize the need for explosion resistance, there is simply no teaching, suggestion, or motivation in Koehler to modify its layer of paint to achieve the thickness claimed by claim 17 or claim 18. Similarly, Mizobe does recognize the need for explosion resistance and, thus, also simply does not teach, suggest, or motivate modification of its reflective coating layer to achieve the thickness claimed by claim 17 or claim 18.

Claims 17 and 18 are therefore in condition for allowance. Reconsideration and withdrawal of the rejection to the same are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is earnestly solicited.

In the alternative, it is believed that this Amendment places the present application in better condition for appeal.

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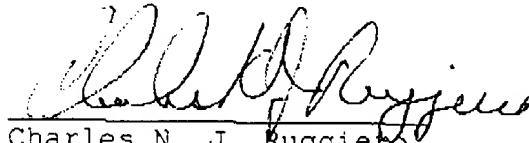
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According, entry and consideration of this Amendment are respectfully requested.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the undersigned attorney for an interview.

Respectfully submitted,

Date: November 12, 2003



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